

REMARKS

Claims 1-9 and 16-25 are pending in the application and stand rejected.

Claim Rejections - 35 U.S.C. § 102

The Examiner rejected claims 1 and 18 under § 102(b) as being unpatentable over Goeb et al. (US 5,688,573).

Claim 1 recites, *inter alia*, evaporating the colored layer and the resin film layer by the laser beam to expose the paper sheet and thereby forming the display on said packaging case.

In the rejection, the Examiner cites to the embodiment disclosed in FIG. 5 as corresponding to the features recited in claim 1. However, because Goeb fails to disclose that the adhesive layer 40 is evaporated, the protective sheet 50 is never exposed. Consequently, Applicants submit this rejection is in error because Goeb fails to disclose “evaporating the colored layer and the resin film layer by the laser beam to expose the paper sheet,” as recited in claim 1.

Thus, Applicants submit claim 1 is allowable for at least this reason. Additionally, because claim 18 recites a similar feature, Applicants submit claim 18 is allowable for at least the same reasons set forth above with regard to claim 1.

Claim Rejections - 35 U.S.C. § 103

The Examiner rejected claims 1, 3, 5-8, 16 and 17 under § 103(a) as being unpatentable over Hughes (US 6,169,266) in view of Ward et al. (US 2,192,423), in further view of Sonobe (US 6,244,176).

In the rejection, the Examiner contends that Hughes teaches a method of forming a display which could inherently be used as a display of a packaging case, but concedes that Hughes is silent with regard to a paper sheet or that the ink is paint or a resin. To compensate for

these deficiencies of Hughes, the Examiner applies Ward as teaching a paper sheet and Sonobe as teaching an ink formed from monomers and oligomers, which the Examiner interprets as a resin. Further, the Examiner alleges it would have been *prima facie* obvious to one of ordinary skill to incorporate the method of Ward and Sonobe into that of Hughes because:

- a) Ward suggests ornamentation, which Hughes provides;
- b) Hughes suggests the method for any article where a design or indicia is required, which Ward provides;
- c) the paper substrate of Ward would provide a reinforcing layer to the invention of Hughes;
- d) Hughes suggests wear resistance inks and the thermosetting inks of Sonobe could be substituted for the ink of Hughes to provide to provide a predictable result.

Claim 1 recites, *inter alia*, evaporating the colored layer and the resin film layer by the laser beam to expose the paper sheet and thereby forming the display on said packaging case.

Despite the Examiner's contentions, Applicants respectfully submit that because Hughes teaches away from etching the entire depth of the undercoat layer 24 (*see* FIG. 3). Rather, Hughes expressly discloses only etching away part of most of the undercoat layer 24. (col. 8, lines 15-28). Moreover, Hughes discloses that this will result in a reduction in contrast. Thus, even if one of ordinary skill in the art would modify Hughes in view of Ward, in view of Hughes express teachings, such a combination would still fail to disclose evaporating the colored layer and the resin film layer by the laser beam to expose the paper sheet and thereby forming the display on said packaging case.

Thus, Applicants submit claim 1 is allowable for at least this reason. Additionally, Applicants submit claims 3, 5-8, 16 and 17 are patentably distinguishable, at least by virtue of their dependency.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 2 and 4 stand rejected under § 103(a) as being unpatentable over Hughes (US 6,169,266) in view of Ward et al. (US 2,192,423), in further view of Sonobe (US 6,244,176) and Robertson (US 6,007,929).

Applicants submit claims 2 and 4 are allowable, at least by virtue of their dependencies.

Claim Rejections - 35 U.S.C. § 103(a)

Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hughes (US 6,169,266) in view of Ward et al. (US 2,192,423), in further view of Sonobe (US 6,244,176) and Yasui (US 5,413,629).

Applicants submit claim 24 is allowable, at least by virtue of its dependency.

Claim Rejections - 35 U.S.C. § 103

The Examiner rejected claim 18-23 as being unpatentable over Hughes (US 6,169,266) in view of Ward (US 2,192,423), and in further view of Cicci (US 4,836,102).

In the rejection, the Examiner applies Hughes and Ward in the same manner as applied to claim 1 above. However, the Examiner concedes that neither Hughes nor Ward disclose that the ink is a polyester or polypropylene resin. To compensate for this deficiency, the Examiner applies Cicci alleging it discloses polyester resin inks. As a reason to combine, the Examiner seems to allege that because Cicci teaches its inks are suggested for a multilayer ink design, one of ordinary skill in the art would combine them with Hughes and Ward.

However, Cicci fails to disclose “evaporating the colored layer and the resin film layer by the laser beam to expose the paper sheet and thereby forming the display on said packaging

case,” as recited in claim 18. Further, as set forth above, neither Hughes nor Ward disclose any such feature. Consequently, even if the references are combined as suggested, Applicants submit the applied combination fails to disclose “evaporating the colored layer and the resin film layer by the laser beam to expose the paper sheet and thereby forming the display on said packaging case.”

Thus, Applicants submit claim 18 is allowable for at least this reason. Additionally, Applicants submit claims 19-23 are allowable, at least by virtue of their dependency.

Claim Rejections - 35 U.S.C. § 103(a)

Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hughes (US 6,169,266) in view of Ward (US 2,192,423) and Cicci (US 4,836,102), in further view of Yasui (US 5,413,629).

Applicants submit that because Yasui fails to compensate for the above noted deficiencies as set forth above with regard to claim 18, claim 25 is allowable, at least by virtue of its dependency.

Conclusion

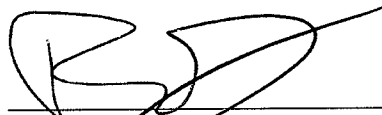
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.116
Application No.: 10/727,505

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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